

REMARKS

This application has been reviewed in light of the Office Action dated March 31, 2003. Claims 1-31 and 36-44 are presented for examination, of which claims 1, 11, 14, 15, 17, 24-31, 38, 41, and 43 are in independent form. Claims 8 and 32-35 have been canceled, without prejudice or disclaimer of subject matter. Claims 1, 9, 11, 14, 15, 17-21, and 24-31 have been amended to define more clearly what Applicant regards as his invention, and claims 2-7, 13, 16, 22, and 23 have been amended as to matters of form. Claims 36-44 have been added to provide Applicant with a more complete scope of protection. Favorable reconsideration is requested.

Applicant notes with appreciation the indication that claims 8 and 9 would be allowable if rewritten so as not to depend from a rejected claim, and with no change in scope. The recitations of allowable claim 8 have been incorporated into independent claim 1. Further, independent claims 24, and 28, method and program claims, respectively, corresponding to system claim 1, have also been amended to include the recitations of allowable claim 8. Independent claims 1, 24, and 28 are believed to be in condition for allowance.

Claims 25, 28, 29, 32 and 33 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, as having insufficient antecedent basis for the feature "second storing step". Cancellation of claims 32 and 33 renders the rejection of those claims moot.

Claims 25, 28, and 29 have been carefully reviewed and amended as deemed necessary to ensure that they conform fully to the requirements of Section 112, second paragraph. Specifically, with regard to claims 25 and 29, Applicant has amended

the phrase "said second storing step" to read "said storing step". Claim 28, Applicant has amended the phrase "a second storing step" to read "a storing step". It is believed that the rejections under Section 112, second paragraph, have been obviated.

Claims 1-3, 5-7, and 10-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. US 2002/0022990 (*Kurata et al.*), in view of U.S. Patent No. 6,129,274 (*Suzuki*), and claim 4 was rejected under Section 113(a) as being unpatentable over *Kurata et al.* as modified by *Suzuki*, and further in view of U.S. Patent No. 5,822,735 (*De Lapa et al.*).

As shown above, Applicant has amended independent claims 11, 14, 15, 17, 25-27, and 29-31 in terms that more clearly define the present invention. Applicant submit that these amended independent claims and new independent claims 41 and 43, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The present invention is directed to an advertising service using a printer or memory cartridge. In conventional systems, as explained in detail in the specification, information stored in a memory cartridge has been used for acquiring operating information but not used for a user service (discount). The present invention addresses the foregoing problems by providing a mechanism that is capable of easily acquiring a printing status and utilization information of advertisement information stored in a memory section in a memory cartridge or in a printer.

The aspect of the present invention set forth in claim 11 is a discounting system that includes first memory means for storing advertisement information, advertisement print means for printing an advertisement based on the advertisement

information stored in the first memory means together with a given print data on media when the given print data is printed, and second memory means, provided in a cartridge detachably mounted on a printer, for storing history information indicating that the advertisement is printed by the advertisement print means. The system also includes acquisition means for acquiring the history information stored in the second memory means, and discount information determination means for determining discount information according to the history information acquired by the acquisition means.

One important feature of claim 11 is storing history information indicating that the advertisement is printed by advertisement print means in a second memory means and discount information determination means for determining discount information according to the history information acquired by the acquisition means. That is, history information, indicating that an advertisement has been printed along with ordinary print data is stored in a specific memory provided in a detachable cartridge, and discount information is generated in accordance with the history information. By virtue of this structure, it is possible to present, upon the collection of used cartridges, for example, a discount to users who have printed an advertisement when printing data with the cartridge.

Kurata et al. relates to an image-forming system using a printer, copier, facsimile machine, or other such image-forming apparatus which forms an image through use of an inkjet method. The *Kurata et al.* system presents "prize data" (lottery determination data) to a user based on data stored in a memory of a cartridge. The prize data may be a URL that only a lottery winner can access, a special keyword or password, printer driver information, mini-game, mini-tool, or other such application program, or image data (paragraph 0078). The *Kurata et al.* system stores data concerning the amount

of ink used in an EEPROM of the cartridge and points are awarded in correspondence to the amount of used ink, and a price is awarded to the user in accordance to respective point levels. However, nothing has been found in *Kurata et al.* that would teach or suggest storing history information indicating that the advertisement is printed by advertisement print means in a second memory means and discount information determination means for determining discount information according to the history information acquired by the acquisition means, as recited in claim 11.

Accordingly, independent claim 11 is believed clearly patentable over *Kurata et al.*, taken alone.

Suzuki relates to a portable electronic IC card which captures transaction information in real time and which manages personal demographic and shopping history data. The *Suzuki* system includes a terminal device that allocates coupon codes to an IC card owned by a customer (column 13, lines 4-15). Based on the coupon code, kiosk terminal 120 displays a message, for example, "You have \$50.00 in value coupons. Push enter to display a list of items which you can purchase using these coupons" (column 13, lines 60-63). Although the *Suzuki* system stores advertisement information on an IC card, nothing has been found in *Suzuki* that would teach or suggest storing history information indicating that the advertisement is printed by advertisement print means in a second memory means and discount information determination means for determining discount information according to the history information acquired by the acquisition means, as recited in claim 11. Even if *Kurata et al.* and *Suzuki* are combined in the manner

proposed in the Office Action, assuming such combination would even be permissible, the resulting combination also would fail to teach or suggest at least those features of claim 11.

Accordingly, claim 11 is believed clearly allowable over *Kurata et al.* and *Suzuki*, taken separately or in any proper combination.

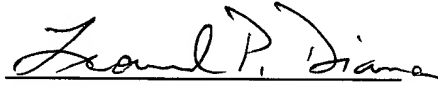
Independent claims 25 and 29 are method and program claims respectively corresponding to system claim 11, and are believed to be patentable for at least the same reasons as discussed above in connection with claim 11. Additionally, independent claims 14, 15, 17, 26, 27, 30, 31, 38, 41, and 43 include the substantially similar features as those discussed above in connection with claim 11. Accordingly, claims 14, 15, 17, 26, 27, 30, 31, 38, 41, and 43 are believed to be patentable for at least the same reasons as discussed above in connection with claim 11.

The other rejected claims in this application depend from one or another of the independent claims discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully request favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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